

REMARKS

In the Office Action mailed February 27, 2008 from the United States Patent and Trademark Office, claims 1-8, 12-15, and 18-24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,332,149 to Warmus et al. (hereinafter “Warmus”) in view of U.S. Patent No. 5,664,178 to Sinofsky (hereinafter “Sinofsky”), and claims 9-11, 16, 17, and 25 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Warmus and Sinofsky in view of allegedly well-known prior art.

Rejections under 35 U.S.C. § 103(a):

Claims 1-8, 12-15, and 18-24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Warmus in view of Sinofsky, and claims 9-11, 16, 17, and 25 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Warmus and Sinofsky in view of allegedly well-known prior art. M.P.E.P. § 2141 sets forth the *Graham* factual enquiries that should be considered when making an obviousness rejection under Section 103: 1) ascertaining the scope and content of the prior art; 2) ascertaining the differences between the claimed invention and the prior art; and 3) resolving the level of ordinary skill in the pertinent art. (Citing *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966).) In addition, M.P.E.P. §§ 2141 and 2142 set forth that “the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit.” (Citing *KSR International Co. v. Teleflex Inc. (KSR)*, 550 U.S. ___, 82 USPQ2d 1385 (2007).)

For a rejection under Section 103 to stand, it must explicitly set forth 1) factual findings showing that each claim element was known in the art at the time of the invention, and 2) factual findings showing that one of ordinary skill in the art, at the time of the invention, would have found it obvious to modify or combine the teachings to arrive at the claimed invention. (See, for

example, the enumerated required articulations set forth in M.P.E.P. § 2143 for each lettered rationale.) In showing that one of ordinary skill in the art would have found it obvious to combine the teachings of multiple references, it is improper to combine references where the references teach away from their combination. M.P.E.P. § 2145; *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983).

Applicant respectfully submits that the references in the Office Action, either alone or in combination, do not teach or suggest all the limitations claimed in the claim set provided herein. Applicant also respectfully submits that the references cited in the Office Action specifically teach against the combination proposed in the Office Action, that the combination is therefore improper, and that the Office Action has therefore failed to show how one of skill in the art would have found it obvious to overcome the differences between the prior art and the claimed invention to arrive at the claimed invention.

Claim 1 requires: “providing a rendering job of a document as a single file in a native format that supports at least one of (i) multiple pages, and (ii) multiple images,” and “storing one or more document indicia as separate sub-images in the single file in the native format.” Thus, claim 1 requires that the separate sub-images be stored in the native format of the single file. Such limitations are not taught by the combination of Warmus and Sinofsky.

Warmus teaches a method and system for providing combined fixed and variable information on a display device such as a printer, i.e. for printing books that have variable information in them. (See Abstract, Col 6 lines 63-65, Figure 2, for example.) However, as acknowledged in the Office Action, the Warmus system does not utilize a single file in a native format that includes the storage of document indicia as separate sub-images in the single file in

the native format, as is required by claim 1. The Office Action relies on Sinofsky as teaching such limitations.

Applicant respectfully disagrees. Sinofsky teaches a disk file/compound document that contains data generated by various applications. In Sinofsky, the data generated by each application is stored in the format utilized by the respective generating program/application. (Col 3 lines 6-19) The generating program/application is then used to re-access that data – in other words, when a word processing data is used to make the compound document and the document includes other data (e.g. graph data and/or spreadsheet data), the graph program or the spreadsheet program is used to access the data within the compound document. (Col 2 lines 48-50; Col 4 line 67-Col 5 line 13) Notably, Sinofsky only discloses a compound document as utilized by a word processing program. (See Col 1 line 31-Col 2 line 25; Col 5 line 57-Col 6 line 13).

Therefore, Sinofsky clearly fails to teach storing one or more document indicia as separate sub-images in the single file in the native format, as is required by claim 1, as the sub-files of Sinofsky are clearly taught as being stored in the format utilized by the respective generating program. Additionally, Warmus clearly teaches against a proposed combination wherein a word processing program is used to produce variable books of the type disclosed in Warmus. Warmus teaches against such a combination as that proposed in the Office Action at least at Column 2 lines 20-46:

Further, if one were to use word processing software to produce book versions it would be necessary to issue commands to separately print the pages of each book version just before such version is to be produced. That is, a user would have to create and store pages to be included in a first book version and then command the software to print as many copies of the first version as are needed. Thereafter, the user would have to recall the pages of the first version from memory, edit and store the pages to create pages to be included in a second book version and then command the system to print the required number of books of the second version.

Similar steps would have to be undertaken for each other book version to be produced. Alternatively, the pages of the different book versions could be created and stored and thereafter printed together. In either event, where many book versions are to be produced, such a process would be quite time-consuming. In addition, image importation and merge routines provided as a part of word processing software are adapted for use on a sub-page basis only and hence are of only limited usefulness in the book production environment. Still further, data manipulated by word processing software are largely (if not entirely) in symbolic format. As a result, data to be displayed or printed must be first rasterized by a raster image processor (RIP), which utilizes complex and time-consuming computational routines which further increase production time to an economically impractical level.

(Emphasis added.)

Because the only compound file disclosed in Sinofsky is one that requires a word processor of the type clearly disparaged in Warmus, and because the system of Sinofsky also requires the use of additional application programs, it is clear that one of skill in the art would not find it obvious to make the proposed combination. One of skill in the art would immediately recognize that the proposed combination would be even more time-consuming and computationally intense within the processes of Warmus than the utilization of the derided word processing program alone. Therefore, for at least this additional reason, Applicant respectfully submits that claim 1 is not made obvious by the cited references, either alone or in combination. Independent claims 13 and 19 contain similar limitations and are allowable for at least the same reasons. All other claims depend from one of claims 1, 13, or 19, and are therefore similarly allowable.

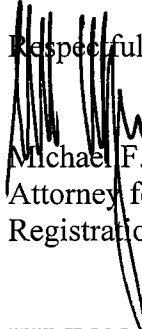
For at least the above reasons, Applicant respectfully requests removal of all rejections under 35 U.S.C. § 103(a).

CONCLUSION

Applicant submits that the amendments made herein do not add new matter and that the claims are now in condition for allowance. Accordingly, Applicant requests favorable reconsideration. If the Examiner has any questions or concerns regarding this communication, the Examiner is invited to call the undersigned.

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Respectfully submitted,


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